



PATENT
Customer No. 22,852
Attorney Docket No. 7451.0002-04
Intertrust Ref. No.: IT-8.4 (US)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
David M. VAN WIE et al.) Group Art Unit: 2131
Application No.: 10/618,427)
Filed: July 10, 2003) Examiner: Not Yet Assigned
For: STEGANOGRAPHIC TECHNIQUES) Confirmation No. 5616
FOR SECURELY DELIVERING)
ELECTRONIC DIGITAL RIGHTS)
MANAGEMENT CONTROL)
INFORMATION OVER INSECURE)
COMMUNICATION CHANNELS)

Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO NOTICE TO FILE
MISSING PARTS OF APPLICATION

Applicants respectfully submit that the Notice to File Missing Parts of Non-Provisional Application mailed December 12, 2005, was issued in error and should be withdrawn. We attach a copy of the Notice at Tab 1.

On February 8, 2006, we communicated the facts set forth below to Formalities Examiner Preston Wallace, Sr. of the Office of Initial Patent Examination, (571) 308-9010 x167. Examiner Wallace indicated that the OIPE appears to have mistaken the information on the CD-ROM as a required part of the application, such as a computer program listing, sequence listing, or table, and issued the Notice in error.

Applicants submit that the materials on the CD-ROM are not a required part of the application and therefore do not need to comply with 37 CFR 1.52(e). Applicants

filed this continuation application with the U.S. Patent and Trademark Office on July 11, 2003 without any information on CD-ROM. Applicants have attached a copy of the postcard showing receipt by the Office at Tab 2.

More than two years after filing, Applicants submitted the CD-ROM that appears to have caused OIPE to issue the Notice to File Missing Parts. On November 8, 2005, Applicants submitted a Notice Regarding Related Litigation including one CD-ROM containing exhibits cited in one of the papers provided with this submission. See Tab 3. The PAIR database indicates that items that could not be scanned (presumably the CD-ROMs filed with the Notice) were received by the USPTO on November 9, 2005. See Tab 4.

As discussed with Examiner Wallace, since the materials submitted on CD-ROM are not required parts of the application *per se*, such as a computer program listing, sequence listing, or table, they are not governed by the requirements in 37 C.F.R. § 1.52(e). Accordingly, Applicants respectfully submit that the Notice requiring Applicants to resubmit the information on these CD-ROMs in the format required by 37 C.F.R. § 1.52(e) to avoid abandonment is in error and should be withdrawn.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 10, 2005

By: 
Andrew B. Schwaab
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2fw

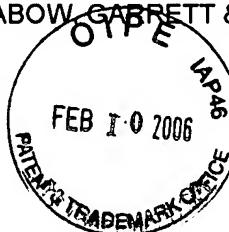


UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
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 Alexandria, Virginia 22313-1450
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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/618,427	07/10/2003	David M. Van Wie	07451 0002-04000

22852
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RECEIVED
 DEC 14 2005

CONFIRMATION NO. 5616

FORMALITIES
 LETTER

Date Mailed: 12/12/2005

FINNEMAN, HENDERSON, FARABOW,
 GARRETT & DUNNER, LLP

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

*Filing Date Granted***Items Required To Avoid Abandonment:**

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given TWO MONTHS from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The compact disc(s) submitted fail to comply with 37 CFR 1.52(e) in that they contain non-ASCII files. A new duplicate set of compact discs with only ASCII files is required. Any replacement compact disc submitted should be accompanied by a certification as required by 37 CFR 1.52(e) that each disc of a duplicate set is identical to the other disc of the set. If a directory of the disc could be printed, it is attached and non-ASCII files are marked on the directory listing.
- The compact disc(s) submitted fail to comply with 37 CFR 1.52(e) in that only a single copy of each disc was provided. A duplicate copy of each compact disc must be provided on Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) media. Any replacement compact discs submitted should be accompanied by a certification as required by 37 CFR 1.52(e) that each disc of a duplicate set is identical to the other disc of the set.
- This application is objected to because it contains a data file on CD-ROM/CD-R, however, the transmittal letter does not list for each compact disc, the machine format, the operating system compatibility, a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the compact disc as required by 37 CFR 1.52(e)(3). A statement listing the required information is required. Additionally, the disc(s) is not identified in the paper portion of the specification with a listing of all of the files contained on the disc. When portions of an application are contained on a compact disc, the paper portion of the specification must identify the compact disc(s) and list the files including name, file size, and creation date on each of the compact discs. See 37 CFR 1.52(e). Applicant(s) are required to amend the specification to identify each disc and the files contained on the disc including the file name, file size, and file creation date.

Replies should be mailed to: Mail Stop Missing Parts

12-14-05 Attorney (10-1st-abs-m2n-fmlw
 Case 1051-001
 Due Date 12-06 w/0-1
 Action Comp Disc's 05
 By

P

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

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*A copy of this notice **MUST** be returned with the reply.*

Office of Initial Patent Examination (571) 272-4000, or 1-800-PTO-9199, or 1-800-972-6382
PART 1 - ATTORNEY/APPLICANT COPY